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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,368	09/24/2001	Helen Ann Biddiscombe	BIDD3001D/JDB	6339

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EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 13-36 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☒ received in Application No. (Series Code/Serial Number) 09/008,292.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. The Examiner notes for the record that applicant's characterization of the pending application as a Divisional of Serial No. 09/008,292 which issued as U.S. Patent 6,306,490B1 is incorrect. There was no restriction requirement set forth in the parent application, and therefore it appears to the Examiner that the proper characterization of the present application is a Continuation.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13-36 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the limitation relating to "improved" (or other more definite language) curl resistance appears to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is again suggested to put this limitation in the ^{independent} claim preamble, as was done in the parent Continuation application.

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4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 96/34742 (Crighton et al. -490 is cumulative) taken either individually or for claims 17-20 and 32 in view of Crighton et al. -601, and for claims 21-24, 27 and 33 in view of Carespodì. WO -742, an example of the applicant's earlier work, discloses (note particularly the five layer film structure set forth in the last seven lines of page 4, as well as page 2, first and third complete paragraphs, page 3, second and third complete paragraphs, page 4, first, third and fourth paragraphs, page 5, second complete paragraph, and the Examples) a genus of polymeric films having biaxially oriented polypropylene cores which are voided, having two intermediate layers of non-voided, polypropylene polymers, as well as two outer skin layers of polypropylene with at least one of the outer layers containing a pigment such as titanium dioxide. The Examiner gives weight to applicant's characterization of his

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invention as a "label", which might thus be described as a film that is cut or segmented into sections, which the reference does not disclose but which are clearly believed well within the ordinary skill of the art. As to the parameter set forth in the last two lines of independent claims 13 and 28, the Examiner notes that such limitation relates to structures that have little or no curl. Such a limitation, as is also set forth in dependent claims 21-24, 27 and 33 is believed to be, if not inherent in the reference disclosure an obvious structural design that the Examiner believes is well within the ordinary skill of the art. Alternatively, Carespodi discloses (note particularly Figure 1, and column 5 lines 8-35, particularly lines 29-35 and Example 1) a laminated polymeric film that can include a voided oriented polypropylene central core layer having additional layers on each of its surfaces. The reference further teaches that if these outer layers are (column 5 lines 29-35) substantially identical and being positioned on opposite sides of the core layer, the resulting symmetrical construction prevents the laminate from curling when it is exposed to heat. Additionally, with respect to the density limitations of claims 17-20 and 32, note that Crighton et al. -601, which discloses a closely related laminated biaxially oriented polypropylene film teaches what the Examiner believes is also well known in the art, namely (column 2 lines 13-18) that films such as those of the present invention can be

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produced having densities "in the range of from 0.55 to 0.80", which is within the range that applicant claims except for dependent claims 19 and 20, which are believed to be within the ordinary skill of the art. Additionally, note that Crighton et al. -601 further discloses such limitations as the presence of outer ~~principal~~ ^{printable} layers (column 2 lines 29-30), the "in-mold" labeling techniques and resulting labels that can be applied to articles (column 1 lines 11-12; column 2 lines 66-67 and also column 3 lines 6-8) films which exhibit the range of thicknesses of applicant's claimed invention. Finally, as to the method claims 34 and 35, the Examiner further believes that adhering the resultant formed genus of labels via an adhesive to a desired substrate is also well within the ordinary skill of the art, in the absence of unexpected results.

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

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7. Claim 28 is rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 8 of prior U.S. Patent No. 6,306,490B1. This is a double patenting rejection.

8. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 28-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,306,490B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the newly presented claims differ from the claims of the patent substantially only in the fact that they are directed to a label, instead of a film as in the relied upon claims of the parent patent.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel

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Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

November 18, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1000~~
1700

Daniel Zirker